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MAILED

MAR 30 2009

OFFICE OF PETITIONS

In re Application of :  
Titball et el. :  
Application No. 10/070882 : ON APPLICATION FOR  
Filed: March 11, 2002 : PATENT TERM ADJUSTMENT  
Atty Docket No. 081238 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT filed December 4, 2008<sup>1</sup>. Citing Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), applicants request that the patent term adjustment be corrected from seventy-eight (78) days to seven hundred fifty-seven (757) days. This request is made in part on the basis that the Office will take in excess of three years to issue this patent.

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is ordinarily required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). It is noted that at the time of this decision, the patent has not issued.

Applicants are given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for

<sup>1</sup> This application was timely filed prior to payment of the Issue Fee on December 30, 2008.

seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

With respect to the over 3 year calculation, rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

With respect to the patent term adjustment at the time of the mailing of the notice of allowance, applicants acknowledge the period of adjustment of 557 days for Office delay and the periods of reduction of 84, 1, 94, 57, 88, and 63 days for applicant delay (in association with the responses filed January 24, 2005; June 24, 2005; September 26, 2005; November 22, 2005; October 29, 2007 and June 16, 2008). Applicants, however, aver that the period of reduction of 92 days for applicant delay pursuant to 37 CFR 1.704(b) is incorrect. In this regard, applicants are advised that the period of reduction of 92 days entered for applicant delay pursuant to 1.704(b)<sup>2</sup> is correct. The Request for Continued Examination ("RCE"), filed February 8, 2007, in response to the final Office action mailed August 8,

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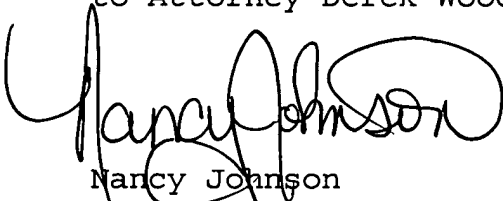
<sup>2</sup> 37 CFR 1.704(b) provides: With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

2006, was filed 92 days after November 8, 2006 - three months after the date of mailing of the final Office action - mailed August 8, 2006.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Attorney Derek Woods at (571) 272-3232.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions